

**REMARKS**

Claims 1 - 9 are pending in the present application.

On 8 APR 2005, the Office mailed a first office action in which claims 1 – 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,893,072 to Matsumoto (hereinafter "the Matsumoto patent") in view of U.S. Patent No. 6,055,285 to Alston (hereinafter "the Alston patent").

On 8 JUL 2005, Applicants mailed a response to the first office action. In the response, Applicants did not amend any claims.

On 2 AUG 2005, the Office mailed the final office action mentioned above, i.e., the office action being referred to herein as "the Office Action." The Office Action is maintaining the rejection of claims 1 – 9 as being unpatentable over the Matsumoto patent in view of the Alston patent.

On 28 OCT 2005, Applicants conducted a teleconference with Examiner Torres to discuss the rejection in the Office Action. Applicants thank Examiner Torres for making time for the teleconference.

Applicants and Examiner did not reach an agreement during the teleconference. However, the Examiner indicated that the Examiner now has a better understanding of Applicants' position regarding the patentability of the claims over the cited references. The Examiner also indicated that Applicants should reiterate that position in a written response, and that the Examiner would then further consider Applicants' position. Accordingly, below, Applicants are reiterating several points that Applicants presented during the teleconference.

Applicants are traversing the section 103(a) rejection of claims 1 – 9.

Claim 1 provides for a testing unit. The testing unit includes, *inter alia*, a signal generator, a receiving unit, and a synchronizing unit for synchronizing a data flow of a signal between a device under test (DUT) and the receiving unit. The synchronizing unit receives a first clock signal from the DUT and a second clock signal from the testing unit. The synchronization unit includes a buffer where a write access onto the buffer is controlled by the first clock signal, and a read access onto the buffer is controlled by the second clock signal.

The Office Action indicates that the Matsumoto patent discloses a receiving unit and a signal generator, and that the Alston patent discloses a synchronizing unit. Thus, the Office Action asserts that the Matsumoto and Alston patents, in combination, disclose the elements of claim 1.

In the Matsumoto patent, a timing signal generator TG provides all clocking throughout the system (FIG. 2, col. 5, lines 21 – 24; and FIG. 5, col. 7, lines 61 – 65). Whereas TG provides all clocking throughout the system, all of the clock signals are synchronous with one another.

The Alston patent is directed toward a synchronization circuit for transferring data between two asynchronous circuits. As explained at col. 6, lines 10 – 16:

[A] transmitting circuit 102 operates in synchronism with a first clock signal (CLOCK1) on a first clock signal line 106, and the receiving circuit 104 operates in synchronism with a second clock signal (CLOCK2) on a second clock signal line 108. The two clock signals operate asynchronously with respect to each other and may have substantially different frequencies. (emphasis added).

Whereas in the Matsumoto patent all clocks are **synchronous** with one another, the system in the Matsumoto patent has **no need for a synchronization circuit** for transferring data between two asynchronous circuits. There is no reason, and therefore **no motive**, to modify the system of the Matsumoto patent to include the synchronizer of

the Alston patent. That Accordingly, the cited combination of the Matsumoto and Alston patents is improper for purposes of a section 103(a) rejection of claim 1.

During the teleconference, the Examiner suggested that if the system of the Matsumoto patent was modified to provide clocks from more than a single generator, there would then be a motive for further modifying the system of the Matsumoto patent to include the synchronizer of the Alston patent. Applicants then explained that a modification of the Matsumoto patent to provide clocks from more than a single generator would be contrary to the Matsumoto patent's express teaching that TG provides all clocking throughout the system, thus **changing the principle of operation** of the system in the Matsumoto patent. Hence, the Matsumoto patent cannot be modified to include the synchronizer of the Alston patent, for purpose of a section 103(a) rejection of claim 1.

In view of the reasoning provided above, Applicants submit that claim 1 is patentable over the cited combination of the Matsumoto and Alston patents.

Claims 2 – 7 depend from claim 1. By virtue of this dependence, claims 2 – 7 are also patentable over the cited combination of references.

Claim 8 is an independent claim and includes recitals similar to those of claim 1, as described above. Thus, for reasoning similar to that provided in support for claim 1, Applicants submit that claim 8 is patentable over the cited combination of references.

Claim 9 depends from claim 8. By virtue of this dependence, claim 9 is also patentable over the cited combination of references.

Applicants respectfully request reconsideration and withdrawal of the section 103(a) rejection of claims 1 – 9.

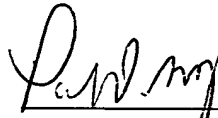
Applicants wish for the Office to note that Applicants have not amended any claim in order to overcome a rejection in either of Applicants' response mailed 8 JUL 2005 or in the present response. As such, Applicants have not made any amendment that would necessitate a new ground of rejection. Accordingly, Applicants respectfully that the Office **withdraw the finality of the Office Action**.

In view of the foregoing, Applicants respectfully submit that all claims presented in this application patentably distinguish over the prior art. Accordingly, Applicants respectfully request favorable consideration and that this application be passed to allowance.

Respectfully submitted,

Date

11/2/05



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